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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,412	10/10/2003	Eugenie Charriere	004900-254	3439

21839 7590 04/20/2005

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/682,412

Applicant(s)

CHARRIERE ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/485,533.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 44-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Adequate support has not been provided for the amendments to claims 44 and 45. Applicants have amended the claims to specify that the true dimer units per isocyanate function(s) ratio is $\leq 30\%$; however, the language of the claims does not correspond to the language of the specification. At page 20 of the specification, the language reads "total true dimer units in the isocyanate functions $\leq 30\%$ "; it is by no means clear that this language is equivalent to the language of the claims. Furthermore, it is by no means clear what is meant by the language of the specification. It cannot be determined if the language sets forth a ratio of dimer units to isocyanate functions (groups) or if the language sets forth the content of dimer units per isocyanate functional compounds.

2. Claims 39-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to provide an adequate written description with respect to the equivalency of the formation of biurets (biuretization) to (cyclo)trimerization. It is not clear that the same methods or catalysts that will yield isocyanurates will yield biurets. Applicants have

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argued that the disclosure at page 14, lines 35+ and original claims 7 and 8 provide adequate written description for the claimed invention. However, the language set forth within the instant claims is not equivalent to the language of the aforementioned disclosure and original claims.

The disclosure and original claims refer to "at least one isocyanate trimer containing an isocyanurate and/or biuret unit", whereas the instant claims merely refer to "a compound containing a biuret unit". In other words, the disclosure and original claims clearly required the compounds at issue to be trimers; however, it is by no means clear that this distinction exists within the instant claim terminology. Accordingly, the position is maintained that applicants have failed to adequately describe how to make biurets using (cyclo)trimerization methods and catalysts.

3. Claims 39-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants have failed to provide enablement for the production of biurets utilizing methods and catalysts for the production of isocyanurates without having to resort to undue experimentation. Applicants' instant claims have been interpreted as requiring the formation of the biuret in the presence of (cyclo)trimerization catalysts under (cyclo)trimerization conditions; however, as aforementioned within paragraph 2, the language of the instant claims is not considered to be equivalent to the language of the disclosure or original claims, which requires the biuret compound to be a trimer. Accordingly, applicants have not provided the requisite enablement that would allow the skilled

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artisan to practice the invention with biuret compounds of the scope now claimed without having to resort to undue experimentation. Applicants have argued that Examples 1, 3, and 12 provide the required guidance to produce biurets; however, the biurets of Examples 1 and 3 are not produced in the presence of a (cyclo)trimerization catalyst; therefore, these examples are not commensurate in scope with the claims. Furthermore, Example 12 refers to a foreign patent document that does not appear to have been incorporated by reference; therefore, within the meaning of the statute, no meaningful guidance can be obtained from this example.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 44 and 45 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 68 of copending Application No. 09/485,533. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is directed to blends of uretdiones and biurets.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Despite applicants' remarks, claim 68 of the copending application has not been amended to exclude the instantly claimed mixtures.

7. Within the claims, the language, "in the absence of dimerization catalyst", is considered to exclude all compounds that serve to catalyze the dimerization of isocyanate groups.

Accordingly, the language is further considered to exclude the presence of (cyclo)trimerization catalysts that serve to also catalyze the aforementioned dimerization of isocyanate groups.

Therefore, in the case of claims 41 and 42, where the (cyclo)trimerization catalysts are used in the step prior to the dimerization step, the aforementioned language is interpreted to require that (cyclo)trimerization catalysts that further catalyze the dimerization of isocyanate groups be removed prior to the dimerization step.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent
April 15, 2005